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MAR 16 2009

OFFICE OF PETITIONS

In re Application of :
Fries, et al. :
Application No. 10/787,345 : **DECISION**
Filed: 26 February, 2004 :
Attorney Docket No. 11000060-0040 :

This is a decision on the petition filed on 17 February, 2009, under the provisions of 37 C.F.R. §1.137(a) seeking revival of the application as having been abandoned due to unavoidable delay; alternatively, under the provisions of 37 C.F.R. §1.181 seeking withdrawal of the holding of abandonment; alternatively, under the provisions of 37 C.F.R. §1.137(b), seeking revival of the application as having been abandoned due to unintentional delay.

The petition under 37 C.F.R. §1.137(a) is **DISMISSED**; the petition under 37 C.F.R. §1.181 is **DISMISSED**; and the petition under 37 C.F.R. §1.137(b) is **DISMISSED**.

Any request for reconsideration of this decision should be filed **within two (2) months** from the mail date of this decision. *Note* 37 C.F.R. §1.181(f). The request for reconsideration should include a cover letter and be entitled as a Renewed Petition to Revive under 37 C.F.R. §1.137(a) (as to unavoidable delay) or Renewed Petition to Revive under 37 C.F.R. §1.137(b) (as to unintentional delay).

This is **not** a final agency action within the meaning of 5 U.S.C. §704.

Petitioner's pleading is a jumble of requests for relief pursuant to: 37 C.F.R. §1.137(a) (unavoidable delay); 37 C.F.R. §1.181 (request to withdraw the holding of abandonment); and 37 C.F.R. §1.137(b) (unintentional delay)—with the petition bearing a title that suggests one vehicle for relief, a second express plea for relief and a third mere suggestion of a vehicle for relief.

In the alternative, Petitioner may properly file a petition to the Commissioner under 37 C.F.R. §1.137(b) requesting revival of an application abandoned due to unintentional delay.

As to Allegation of
Unavoidable Delay

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(a) are the petition and fee therefor, a reply, a proper showing of unavoidable delay under the regulation, and, where applicable, a terminal disclaimer and fee. (However, it does not appear that a terminal disclaimer and fee are due here.)

Petitioner does not appear to have satisfied—or be able to satisfy—the showing requirements under the rule.

As to the Request to Withdraw
the Holding of Abandonment

Petitioner's attention is directed to the Commentary at MPEP §711.03(c)(I) for guidance as to the proper showing and timeliness requirements for relief under 37 C.F.R. §1.181.

Petitioner appears not to satisfy—or be able to satisfy—the showing requirements set forth in the guidance in the Commentary at MPEP §711.03(c)(I).

For reference: Petitioner's attentions are directed to the guidance set forth in the Commentary at MPEP §711.03(c)(I)—and with particularity to the requirements therein of statements of non-receipt at the address of record, search and non-discovery, with a description of docketing system and a statement of its reliability, and support for those the statements with copies of the docket record/file jacket cover and due date calendar/docket. (The requirements of the regulations at under 37 C.F.R. §1.181 also impose upon a Petitioner a duty to seek relief there under within two (2) months of the act complained of.)

As to Allegation of
Unintentional Delay

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a reply, a proper /statement showing of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee. (However, it does not appear that a terminal disclaimer and fee are due here.)

Petitioner does not appear to have satisfied the statement requirements under the rule and should make his fee authorization express. Petitioner also should ensure that the proper party—i.e., the attorney under whose control the application went abandoned—makes the express statement of unintentional delay.

BACKGROUND

The record reflects as follows:

Petitioner failed to reply to the non-final Office action mailed on 19 December, 2007, with reply due absent extension of time on or before 19 March, 2008.

The application went abandoned by operation of law after midnight 19 March, 2008.

On 12 May, 2008, Petitioner's office sought status in the matter after it appears that Counsel Michael W. Maddox (Reg. No. 47,764) moved from one law firm to another, and on 27 August, 2008, Petitioner's office attempted to revoke/submit a power of attorney, however, the Office Noticed the former office of Mr. Maddox that the required certificate pursuant to 37 C.F.R. §3.73(b) had not been received.

The Office mailed the Notice of Abandonment on 23 September, 2008.

On 30 October, 2008, Petitioner filed a revocation/power of attorney, which the Office acknowledged on 7 November, 2008.

On 13 November, 2008, Petitioner filed a petition averring, *inter alia*, non-receipt, and sought withdrawal of the holding of abandonment pursuant to 37 C.F.R. §1.181, but failed to comply with the express requirements for showing required herein as set forth at MPEP 711.03(c)(I)—including but not limited to the statement of search and non-discovery, the description as to the docketing and/or calendaring system and its reliability, and required documentary support of the docket sheet (or file jacket cover) of the instant application and the due date calendar for the reply in question. Moreover, there is no statement from Mr. Maddox as the registered practitioner who oversaw the matter at the time of abandonment, nor from Petitioner. Thus, Petitioner failed to demonstrate that the Office action in question was not received (and so docketed, that the system provides sufficient and reasonable reliability and that it therefore does not appear either on the application docket sheet or on the due-date calendar for reply.

Petitioner averred that the delay was unavoidable and expressly invoked the provisions of the regulations under 37 C.F.R. §1.137(a), and, the fee was authorized and was charged to Deposit Account 19-3140, however, Petitioner failed to satisfy the regulatory (showing) requirements pursuant to the rule. The petition was dismissed on 15 December, 2008

From the history of this matter, as set out above, it appears that Petitioner's office attempted to move the prosecution of the instant application from one law firm to another and in doing so did not keep track of the Office action in question. Such is not the basis for a petition to revive pursuant to 37 C.F.R. §1.137(a) or a request to withdraw the holding of abandonment pursuant to 37 C.F.R. §1.181.

Nonetheless, on 17 February, 2009, Petitioner reasserted his petitions pursuant to 37 C.F.R. §1.137(a) and pursuant to 37 C.F.R. §1.181—and threw in a suggestion of a request for relief pursuant to 37 C.F.R. §1.137(b).

As to the Holding of Abandonment

Petitioner places into the record statements that do not satisfy the \showing requirements set forth in the guidance in the Commentary at MPEP §711.03(c)(I)—as summarized above, and set forth *in extenso* in the decision of 15 December, 2008, and again hereinbelow.

The discussion at MPEP 711.03(c)(I) provides in pertinent part:

The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner describing the system used for recording an Office action received at the correspondence address of record with the USPTO. The statement should establish that the docketing system is sufficiently reliable. It is expected that the record would include, but not be limited to, the application number, attorney docket number, the mail date of the Office action and the due date for the response.

Practitioner must state that the Office action was not received at the correspondence address of record, and that a search of the practitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received. A copy of the record(s) used by the practitioner where the non-received Office action would have been entered had it been received is required.

A copy of the practitioner's record(s) required to show non-receipt of the Office action should include the master docket for the firm. That is, if a three month period for reply was set in the nonreceived Office action, a copy of the master docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. If no such master docket exists, the practitioner should so state and provide other evidence such as, but not limited to, the following: the application file jacket; incoming mail log; calendar; reminder system; or the individual docket record for the application in question.¹

¹ See: MPEP §711.03(c)(I)(A).

As to Unavoidable Delay

The showing requirements as to unavoidable are significant and demanding.

Yet Petitioner's submissions are confused—in addition to the overall confusion of the paper (as discussed above):

- The Status Inquiry that Petitioner avers was submitted on 12 May, 2008, refers to a non-existent Office action of “December 4, 2007.” Office records evidence that the Examiner mailed non-final Office actions on 5 June, 2007, and again on 10 December, 2007—however, no Office action appears in the instant application on the date stated by Petitioner. Thus, what records Petitioner had or averred to have had appear unreliable at best.
- The statements by the former Patton Boggs Senior IP Docket Clerk Elizabeth Stafford (Ms. Stafford) and by a former Patton Boggs IP Docket and File Coordinator Zaincorie Taylor-Smith (Ms. Taylor-Smith) are more than a year after-the-fact. Moreover, Ms. Stafford's statement indicates that Ms. Taylor-Smith was but one of several persons in her position—and therefore might not see all materials received—while Ms. Taylor-Smith suggests that she was the lone person in her position. And Ms. Stafford appears to have been not only the more-senior employee but also the more-longstanding employee.
- The first—and unsuccessful—attempt to file a Revocation/Power of Attorney clearly was based upon a document executed on 7 May, 2008—almost four (4) months before Petitioner sought to file the papers on 27 August, 2008. Apparently the process of Mr. Maddox's move from Patton Boggs to Sonnenschein Nath & Rosenthal LLP was in process long before any Notice was sent to the Office, and such delay suggests weaknesses in the organization of the move and the processing of/accounting for other papers.

This is not evidence of a system upon which and/or at a time one might rely for dependability.

The discussion of a showing as to unavoidable delay is set forth in the guidance in the Commentary at MPEP §711.03(c)(II), which provides in pertinent part:

2.Unavoidable Delay

As discussed above, “unavoidable” delay is the epitome of “unintentional” delay. Thus, an intentional delay precludes revival under 37 C.F.R. §137(a) (“unavoidable” delay) or 37 C.F.R. §1.137(b) (“unintentional” delay). See *Maldague*, 10 USPQ2d at 1478.

Decisions on reviving abandoned applications on the basis of “unavoidable” delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word ‘unavoidable’ . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Pratt, 1887 Dec. Comm’r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 667-68 (D.D.C. 1963), aff’d, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm’r Pat. 139, 141 (1913). In addition, decisions on revival are made on a “case-by-case basis, taking all the facts and circumstances into account.” Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was “unavoidable.” Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

A delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of “unavoidable” delay, provided it is shown that:

- (A) the error was the cause of the delay at issue;
- (B) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; and
- (C) the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.

See In re Egbers, 6 USPQ2d 1869, 1872 (Comm’r Pat. 1988), rev’d on other grounds sub nom., Theodor Groz & Sohne & Ernst Bechert Nadelfabrik KG v. Quigg, 10 USPQ2d 1787 (D.D.C. 1988); In re Katrapat, 6 USPQ2d 1863, 1867-68 (Comm’r Pat. 1988). For example, where an application becomes abandoned as a consequence of a change of correspondence address (the Office action being mailed to the old, uncorrected address and failing to reach the applicant in sufficient time to permit a timely reply) an adequate showing of “unavoidable” delay will require a showing that due care was taken to adhere

to the requirement for prompt notification in each concerned application of the change of address (see MPEP § 601.03), and must include an adequate showing that a timely notification of the change of address was filed in the application concerned, and in a manner reasonably calculated to call attention to the fact that it was a notification of a change of address. The following do not constitute proper notification of a change in correspondence address:

(A) the mere inclusion, in a paper filed in an application for another purpose, of an address differing from the previously provided correspondence address, without mention of the fact that an address change was being made;

(B) the notification on a paper listing plural applications as being affected (except as provided for under the Customer Number practice - see MPEP § 403); or

(C) the lack of notification, or belated notification, to the U.S. Patent and Trademark Office of the change in correspondence address.

Delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP, however, does not constitute “unavoidable” delay. See *Haines*, 673 F. Supp. at 317, 5 USPQ2d at 1132; *Vincent v. Mossinghoff*, 230 USPQ 621, 624 (D.D.C. 1985); *Smith v. Diamond*, 209 USPQ 1091 (D.D.C. 1981); *Potter v. Dann*, 201 USPQ 574 (D.D.C. 1978); *Ex parte Murray*, 1891 Dec. Comm’r Pat. 130, 131 (1891). For example, as 37 C.F.R. 1.116 and 1.135(b) are manifest that proceedings concerning an amendment after final rejection will not operate to avoid abandonment of the application in the absence of a timely and proper appeal, a delay is not “unavoidable” when the applicant simply permits the maximum extendable statutory period for reply to a final Office action to expire while awaiting a notice of allowance or other action.

Likewise, as a “reasonably prudent person” would file papers or fees in compliance with 37 C.F.R. §1.8 or §1.10 to ensure their timely filing in the USPTO, as well as preserve adequate evidence of such filing, a delay caused by an applicant’s failure to file papers or fees in compliance with 37 C.F.R. §1.8 and §1.10 does not constitute “unavoidable” delay. See *Krahn*, 15 USPQ2d at 1825. Finally, a delay caused by an applicant’s lack of knowledge or improper application of the patent statute, rules of practice or the MPEP is not rendered “unavoidable” due to: (A) the applicant’s reliance upon oral advice from USPTO employees; or (B) the USPTO’s failure to advise the applicant of any deficiency in sufficient time to permit the applicant to take corrective action. See *In re Sivertz*, 227 USPQ 255, 256 (Comm’r Pat. 1985).

35 U.S.C. §133 and §151 each require a showing that the “delay” was “unavoidable,” which requires not only a showing that the delay which resulted in the abandonment of the application was unavoidable, but also a showing of unavoidable delay until the filing

of a petition to revive. See *In re Application of Takao*, 17 USPQ2d 1155 (Comm'r Pat. 1990).

The burden of continuing the process of presenting a grantable petition in a timely manner likewise remains with the applicant until the applicant is informed that the petition is granted. *Id.* at 1158. Thus, an applicant seeking to revive an “unavoidably” abandoned application must cause a petition under 37 C.F.R. §1.137(a) to be filed without delay (i.e., promptly upon becoming notified, or otherwise becoming aware, of the abandonment of the application).

An applicant who fails to file a petition under 37 C.F.R. §1.137(a) “promptly” upon becoming notified, or otherwise becoming aware, of the abandonment of the application will not be able to show that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(a) was unavoidable. The removal of the language in 37 C.F.R. §1.137(a) requiring that any petition thereunder be “promptly filed after the applicant is notified of, or otherwise becomes aware of, the abandonment” should **not** be viewed as: (A) permitting an applicant, upon becoming notified, or otherwise becoming aware, of the abandonment of the application, to delay the filing of a petition under 37 C.F.R. §1.137(a); or (B) changing (or modifying) the result in *In re Application of S*, 8 USPQ2d 1630 (Comm'r Pat. 1988), in which a petition under 37 C.F.R. §1.137(a) was denied due to the applicant's deliberate deferral in filing a petition under 37 C.F.R. § 1.137. An applicant who deliberately chooses to delay the filing of a petition under 37 C.F.R. §1.137 (as in *Application of S*, 8 USPQ2d at 1632) will not be able to show that “the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to [37 C.F.R. §1.137(a)] was unavoidable” or even make an appropriate statement that “the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to [37 C.F.R. §1.137(b)] was unintentional.”

The dismissal or denial of a petition under 37 C.F.R. §1.137(a) does not preclude an applicant from obtaining relief pursuant to 37 C.F.R. 1. §137(b) on the basis of unintentional delay (unless the decision dismissing or denying the petition under 37 C.F.R. 1.137(a) indicates otherwise). In such an instance, a petition under 37 C.F.R. 1.137(b) may be filed accompanied by the fee set forth in 37 C.F.R. §1.17(m), the required reply, a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional, and any terminal disclaimer required by 37 C.F.R. §1.137(c). Form PTO/SB/61 or PTO/SB/61PCT may be used to file a petition for revival of an unavoidably abandoned application.

As to Unintentional Delay

Petitioner suggests at the end of the first paragraph at page one of the petition, that Petitioner alternatively seeks relief pursuant to 37 C.F.R. §1.137(b)—“because the failure to reply was unavoidable *** (or if determined by the Examiner unintentional).” (Emphasis supplied.)

It is not the role of the Office to guess at or otherwise interpret Petitioner’s intentions.

If Petitioner seeks to request revival of the instant matter properly pursuant to 37 C.F.R. §1.137(b), it is Petitioner’s responsibility to so plead with a proper petition fee/fee authorization, reply and statement of unintentional delay.

Out of an abundance of caution, Petitioners always are reminded that the filing of a petition under 37 C.F.R. §1.181 does not toll any periods that may be running any action by the Office and a petition seeking relief under the regulation must be filed within two (2) months of the act complained of (*see*: 37 C.F.R. §1.181(f)), and that those registered to practice and all others who make representations before the Office are reminded to inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation—since all owe to the Office the continuing duty to disclose.²

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application.

STATUTES, REGULATIONS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).

Allegations as to the Request to
Withdraw the Holding of Abandonment

The guidance in the Commentary at MPEP §711.03(c)(I) specifies the showing required and how it is to be made and supported.

Petitioner failed to make the showing required.

² See supplement of 17 June, 1999. The Patent and Trademark Office is relying on Petitioner’s duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

As to Allegations of
Unavoidable Delay

The requirements under 37 C.F.R. §1.137(a) have not been satisfied as of this writing in that Petitioner failed to make the showing of unavoidable delay as required.

As to Allegations of
Unintentional Delay

The requirements under 37 C.F.R. §1.137(b) have not been satisfied as of this writing in that Petitioner failed to make the express statement of unintentional delay as required—and, in fact, may not be the proper person to do so in that it appears that the instant application was under the control of another at the time the application went abandoned.

CONCLUSION

Accordingly, the petition under 37 C.F.R. §1.137(a) is **dismissed**; the petition under 37 C.F.R. §1.181 is **dismissed**; and the petition under 37 C.F.R. §1.137(b) is **dismissed**.

ALTERNATIVE VENUE

Should Petitioner wish to revive the application, Petitioner may wish to properly file a petition to the Commissioner requesting revival of an application abandoned due to unintentional delay under 37 C.F.R. §1.137(b). (See: http://www.uspto.gov/web/offices/pac/mpep/documents/0700_711_03_c.htm#sect711.03c)

A petition to revive on the grounds of unintentional delay must be filed promptly and such petition must be accompanied by the reply, the petition fee, a terminal disclaimer and fee where appropriate and a statement that “the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional.” (The statement is in the form available online.)

Further correspondence with respect to this matter should be addressed as follows:

By Mail: Mail Stop PETITION
 Commissioner for Patents
 P. O. Box 1450
 Alexandria, VA 22313-1450

By hand: U. S. Patent and Trademark Office
Customer Service Window, Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

By facsimile: (571) 273-8300
Attn: Office of Petitions

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214—it is noted, however, that all practice before the Office is in writing (see: 37 C.F.R. §1.2³) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).



/John J. Gillon, Jr./
John J. Gillon, Jr.
Senior Attorney
Office of Petitions

³ The regulations at 37 C.F.R. §1.2 provide:

§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.